

Application No. 10/702,206  
Response to Office Action

Customer No. 01933

### R E M A R K S

Entry of this Amendment and reconsideration of this application as amended are respectfully requested.

Claims 1-20 and new claims 29-36 are pending in this application, claims 21-28 having been canceled. Claims 1-9 have been rejected. Claims 10-20 have been withdrawn from consideration as being directed to a non-elected embodiment.

Claims 1 and 5-10 are amended. Unless an argument is made below in support of the patentability of each of these claims over cited prior art in view of changes to the claim, the changes do not relate to patentability.

#### Election/Restriction

In response to the earlier election of species requirements, claims 21-28, drawn to a non-elected embodiment, have been canceled without prejudice to filing a divisional application directed to the subject matter of these claims.

Claims 10-20, also directed to a non-elected embodiment, remain in the application and it is respectfully submitted that if claim 1 is deemed allowable, claims 10-20 should be considered for rejoinder (see MPEP 821.04).

#### Abstract

In response to the Examiner's indication that the Abstract is more than 150 words, the Abstract has been revised to be less than 150 words.

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Claim Rejections-35 USC 112

Claim 1 has been amended to remove the informalities noted by the Examiner and thereby overcome the rejection of claim 1 under 35 USC 112, second paragraph.

Claim Rejections-35 USC 102 and 35 USC 103

Claims 1, 3-5 and 7 are rejected under 35 USC 102(b) as being anticipated by Bustos (U.S. Des. 277,969). Claim 2 is rejected under 35 USC 103(a) as being unpatentable over Bustos in view of Meyer (U.S. Des. 381,362).

The Examiner's rejections are traversed in view of amendments to independent claim 1.

Claim 1 is now directed to a sorter/organizer including at least three substantially planar walls arranged substantially parallel to one another, side walls connected to the at least three walls, and a first, stepped bottom wall connected to at least three of the walls and at least one side walls. At least two compartments are formed, each by an adjacent pair of the at least three walls and the first bottom wall. At least one of the side walls has upper edge portions connected to the first bottom wall. The sorter/organizer also includes a plurality of ledges, each arranged at a respective end of a compartment and each extending above the upper edge portion of the side wall at the respective end of that compartment.

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An important feature of the embodiment of the invention now set forth in claim 1 is that each ledge extends "only partially along a height of said adjacent pair of said at least three walls forming said compartment such that at least one side of said compartment is open above said ledge to enable objects received in said compartment to extend laterally outward therefrom above said ledge and such that an upper surface of said ledge is above a bottom of said compartment to prevent objects received in said compartment and contacting the bottom of said compartment from inadvertently slipping out therefrom". As discussed in the specification at page 17, lines 11-19, the height of the ledges 58 is considerably smaller than the height of the front, rear and dividing walls 12, 14, 42, 44 (the at least three walls of claim 1) so that the side of the compartments 36, 38, 40 are almost completely open to avoid a restriction on the size of objects that can be received in the compartments 36, 38, 40. However, the presence of the ledges prevents file folders and other objects, which are lengthwise smaller than the compartments and in contact with the bottom of the compartments, from inadvertently slipping out of the compartments 36, 38, 40 (see page 17, lines 5-9). Thus, the ledges 58 serve complementary functions depending on the size of the objects received in the compartments.

Bustos shows a desk organizer with compartments each defined by an adjacent pair of parallel, planar walls and a planar bottom

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wall (see Fig. 3). On one side, the compartments are totally closed by a side wall (the far side in Fig. 1) and on the other side, the compartments are totally open (the near side in Fig. 1).

In contrast to the present claimed invention, Bustos does not disclose, teach or suggest ledges extending only partially along a height of an adjacent pair of parallel, planar walls. Rather, Bustos shows a side wall which extends entirely along the height of the adjacent pair of parallel, planar walls to close the side of the compartment (the side wall on the far side of the organizer in Fig. 1), or no wall at all to create an open side of the compartment (on the near side of the organizer in Fig. 1). Therefore, Bustos cannot teach or suggest the present claimed invention.

In view of the changes to claim 1 and the arguments presented above, it is respectfully submitted that claim 1 patentably distinguishes over Bustos under 35 USC 102.

Claims 2-5 and 7, which are either directly or indirectly dependent on claim 1, are patentable over Bustos alone or in combination with Meyer in view of their dependence on claim 1 and because Bustos and Meyer do not disclose, teach or suggest all of the limitations recited in the dependent claims.

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In view of the foregoing, applicant respectfully requests withdrawal of the rejections of claims 1-5 and 7 under 35 USC 102(b) and 103(a).

Double Patenting

Claims 1-9 are rejected on the grounds of obviousness-type double patenting in view of the claim of U.S. Des. 495,007. Claims 1-5 and 7-9 are also rejected on the grounds of obviousness-type double patenting in view of the claim of U.S. Des. 497,391.

The Examiner's rejections are traversed on the grounds that the sorter/organizers of the '007 and '391 patents include ornamental features which render the claims unobvious in view of the claims of the instant utility patent application.

These rejections are double patenting rejections of claims in a utility patent application in view of claims in design patents. In *Carman Industries, Inc. v. Wahl*, 220 USPQ 481 (Fed. Cir. 1983), the CAFC stressed that one attempting to show double patenting in such a situation bears a heavy burden of proof as double patenting is rare in the context of utility versus design patents. Subsequently, in *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999), the CAFC applied a "two-way" test to overturn an Examiner's double patenting rejection of claims in a utility patent application in view of claims in design patents. This two-way test is whether the subject matter of the claims of the

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application would have been obvious in view of the subject matter of the claims of the patent and vice versa. See, *Carman Industries and Dembiczak*.

In this case, at least one prong of this two-way test is not satisfied because the subject matter of the claims of the '007 and '391 design patents is not obvious in view of the subject matter of the claims of the instant utility application. Specifically, the claims of the '007 and '391 design patents include ornamental features which are entirely absent from and not an obvious variation of the claims of the instant application. For example, the front, rear and dividing walls in the inventions claimed in the '007 and '391 design patents have a prominent curvature. This curvature is formed such that the side edges of the front, rear and dividing walls are at substantially the same vertical height and then dip to a center to thereby form a curve having a partial sinusoidal form.

None of the claims of the instant application describe the front, rear and dividing walls having a curvature. Moreover, the formation of a curvature having the specific form shown in the '007 and '391 design patents is not obvious in view of the claims of the instant application, as a reference disclosing a teaching or suggestion of such obviousness has not been applied by the Examiner.

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Since the subject matter of the claims of the '007 and '391 design patents would not have been obvious in view of the subject matter of the claims of the instant application, one prong of the two-way test is not satisfied. Therefore, the double patenting rejection of claims 1-9 in view of the claims of the '007 and '391 design patents has been overcome and should be withdrawn.

#### New Claims

Claims 29-36 are presented and all are directed to the elected species of the invention. Therefore, claims 29-36 should be considered together with claims 1-9 in this application.

Claims 29-31 depend from claim 1.

Claim 32 is a new independent claim which includes subject matter from claim 6. Claim 33 depends on claim 32.

Claim 34 is another new independent claim which includes subject matter from claim 8. Claims 35 and 36 depend on claim 34.

#### Authorization to Charge Fee

As previously set forth, the application included 28 claims of which 2 were independent, and the appropriate claim fee was paid for such claims. The application now contains 28 claims, of which 3 are independent. Accordingly, no fee is due for the presentation of claims 29-36. Nevertheless, if any fees are determined to be required for the presentation of claims 29-36 or entry of this Amendment, authorization is hereby given to charge any such fees to Deposit Account No. 06-1378.

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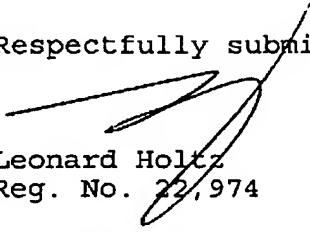
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In view of the foregoing, allowance of the claims and the passing of this application to issue are respectfully solicited.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

Respectfully submitted,

  
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